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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,285	10/20/2000	Leon A. Pintsov	F-214	8085

7590

02/03/2003

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EXAMINER

HUSEMAN, MARIANNE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/693;285

Applicant(s)

PINTSOV, LEON A.

Examiner

M. Huseman

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because descriptive labels, other than numerical are needed for figure 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. See 37 CFR § 1.84(o).

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear as to where in the specification there is disclosure for "...said value-added request is an electronic communication"; i.e., it appears from the disclosure that it is only the notification of receipt that is electronically communicated and not the actual request for the value-added service.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pintsov '036 in view of USPS "3 Special Services" and PS Form 2865.

Regarding claims 1 – 3, 7 – 11, 16 and 17:

Pintsov teaches a postage payment system with security for sensitive mailer data and enhanced carrier data functionality such that Applicant's step of combining a set of value-added services into a machine readable mark on a mailpiece reads on figure 1, element 108, Applicant's step of reading said mark at a second handling postal authority

reads on the destination country receiving the mailpiece and interpreting the mark, Applicant's step of performing the valued added service reads on the destination country performing the value-added service, Applicant's step of sending a message to said first handling postal authority reads on the destination country (second handling postal authority) sending completed form 2865 to the first handling postal authority (USPS) and Applicant's step of determining an original mailer electronic address at said first handling authority reads on element 106.

While Pintsov does not teach the use of his system for international purposes, the USPS has a relationship with many countries wherein value added services, such as return receipt/confirmation of delivery, are performed. As evidenced by the PS Form 2865, the value added service of return receipt between the USPS and other countries has been performed at least since March of 1985. Applicant's creating a machine readable mark for the processing of domestic mail, including a mailer identification code and value-added service data, is disclosed in Pintsov '036 which dates as far back as July, 1994. USPS "3 Special Services" indicates the procedure the other country follows with regard to the value-added service of return receipt for international mailpieces. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Pintsov '036 to include international handling of value added service requests along with it's handling of domestic mail as it will widen the marketability, and thus profits, of the Pintsov '036 system and streamline the handling of value added services regardless of whether the mail is domestic or international.

Regarding claims 4, 12 – 15, 18 – 20 and 22:

Pintsov '036 discloses that confirmation of receipt may be sent electronically, column 10, lines 52 – 54. See paragraph 3, above with regard to claim 15.

Regarding claims 5, 6 and 21:

While Pintsov '036 does not disclose notification via fax or telephone, it is considered that it would have been obvious to one of ordinary skill in the art that this notification could be done either by fax or telephone as a matter of design choice as these are considered to be similar forms of communication.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gordon et al teach the use of e-mail notification and the use of databases for corresponding indicia to the information within those databases.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277.

The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

  
M. Huseman  
Examiner  
Art Unit 3621

mh  
January 26, 2003